

Appl. No. 09/843,002
Amdt. Dated February 10, 2004
Reply to Office Action of November 18, 2003

Attorney Docket No. 81870.0018
Customer No.: 26021

REMARKS/ARGUMENTS:

Claims 1-19 are pending in the application. Reexamination and reconsideration of the application, in view of the following remarks, are respectfully requested.

The present invention relates to a carrier for optical semiconductor device and a mounting structure thereof used in optical fiber communication system or optical local area network, and further relates to an optical semiconductor module on which optical wave guide elements such as the carrier for optical semiconductor device, an optical fiber coupled thereto and an optical wave guide channel are mounted. (Applicant's specification, at p. 1, lines 5-11).

CLAIM REJECTIONS UNDER 35 U.S.C. § 103:

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Setoguchi (U.S. Patent No. 6,467,972) in view of Saito (U.S. Patent No. 6,377,385). Applicant respectfully traverses this rejection.

Applicant respectfully submits that under 35 U.S.C. §103(c), Setoguchi does not preclude the patentability of the present invention because Setoguchi is owned by the assignee of the present invention, Kyocera Corporation. 35 U.S.C. § 103(c) states that:

"Subject matter developed by another person, which qualifies as prior art only under one more subsections of (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time of the invention was made, owned by the same

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person or subject to an obligation of assignment to the
same person."

The Setoguchi patent issued October 22, 2002 upon an Application filed February 27, 2001. The Setoguchi patent is and was assigned to Kyocera Corp. The assignment is recorded with the U.S. Patent and Trademark Office at reel/frame 011582/0408. The instant Application was filed on April 25, 2001. The instant Application is also assigned to Kyocera Corp. The assignment is recorded with the U.S. Patent and Trademark Office at reel/frame 011766/0329.

Based on the foregoing, Applicants believe that Setoguchi can only be prior art under 102(e), 102(f) or 102(g). Pursuant to MPEP 706.02(l)(2), Applicant believes that Setoguchi does not preclude the patentability of the present invention. Applicant files concurrently herewith a statement concerning common ownership. Withdrawal of this rejection is thus respectfully requested.

ALLOWABLE SUBJECT MATTER:

Claims 6-19 are allowed.

The art made of record but not relied upon by the Examiner has been considered. However, it is submitted that this art neither describes nor suggests the presently claimed invention.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 337-6810 to discuss the steps necessary for placing the application in condition for allowance.

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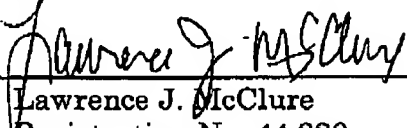
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If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

Date: February 10, 2004

By: _____


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